

REMARKS

Claims 1-36 are pending in this application.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Riley during the January 14, 2009 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

I. The Claims Are Patentable Over The Applied References

The Office Action (1) rejects claims 1-10, 15-24, 29-34 and 36 under 35 U.S.C. §103(a) over U.S. Patent No. 6,678,064 to Bruce in combination with U.S. Patent No. 4,806,978 to Nakatani; and (2) rejects claims 11-14, 25-28 and 35 under 35 U.S.C. §103(a) over Bruce and Nakatani, and further in view of U.S. Patent No. 6,288,790 to Yellepeddy. Applicants respectfully traverse the rejections.

A. Independent Claims 1, 15, 29 and 36

Regarding independent claims 1, 15, 29 and 36, the proposed combination of references fails to disclose all the claimed features because it would not have been obvious to make the proposed combination.

Regarding independent claims 1, 15, 29 and 36, the Office Action cites to Bruce: (1) at col. 4, lines 34-36 and 59-65 as allegedly disclosing the claimed receiving unit; (2) at col. 5, lines 6-8 as allegedly disclosing the claimed memory; (3) at col. 9, lines 25-28, discussing touch screen 320, as allegedly disclosing the claimed controller; and (4) at col. 10, lines 4-13 as allegedly disclosing a printing mechanism. The Office Action acknowledges that Bruce does not disclose "the print request not being edited by the editing of the printing data" and "the editing of the printing data not including editing of a printing sequence of print requests received by the image forming device", but cites to Nakatani as allegedly curing these deficiencies. The Office Action cites to Nakatani at col. 4, lines 13-24 as allegedly disclosing the editing of print data. The Office Action alleges that it would have been obvious to modify

Bruce by Nakatani to provide "highly efficient edited-image copying", citing to Nakatani at col. 5, lines 1-2.

Nakatani discloses an input unit 901 (Fig. 7) that enables entry of simple editing commands for editing images on copy machines (col. 2, lines 4-5). Nakatani discloses that copy machines that allow editing are inefficient because it takes a long time for users to edit images for copying on a copy machine, causing other users to wait (col. 1, lines 17-23). Thus, input unit 901 is a standalone module that is "independent of the copy machine" (col. 4, lines 14-16) to solve this problem. Input unit 901 accepts a memory card 903 in insert section 915 (col. 4, lines 48-52). Input unit 901 allows entry of editing data for the editing of images and stores the editing data onto memory card 903 (col. 5, lines 31-32). In operation, input unit 901 enables entry of editing data without holding up use of the copy machine and, once the memory card 903 is inserted into a copy machine, the copy machine implements the editing data on the memory card 903 in copying an image (see Fig. 10).

It would not have been obvious to modify Bruce by Nakatani because the references taken as a whole do not provide any reason to make the proposed combination. First, the configuration of the systems of Bruce and Nakatani do not provide a reason to combine. Bruce discloses a printer document viewer for use on a printing system 100. Further, Bruce's printer 130 does not have a memory card reader, and leads away from this by disclosing that printer 130 is networked (col. 4, lines 54-59). In contrast, Nakatani discloses a copy machine that has an opening 50 for reading a memory card containing editing data produced on input unit 901. Because Nakatani is directed to addressing a problem associated with some copy machines not present in the printers of Bruce, and because the printers of Bruce lack the capability of receiving floppy disks, the references, taken as a whole, do not provide any reason to combine the references as proposed.

Second, Nakatani discloses that input unit 901 is provided to address the problem associated with copy machines (not printers), that copy machines which enable editing of copied images can cause delays for subsequent users (col. 1, lines 12-16). Bruce does not disclose that printing device 130 allows editing of data on printing device 130. Thus, the problem addressed by Nakatani does not exist in Bruce and the proposed combination is not supported by the references taken as a whole.

Third, Bruce's printing devices 130 are general printers able to print documents. Nakatani's copy machines copy documents. One of ordinary skill would have recognized that there is great benefit to allowing the simple editing commands of Nakatani during the copying process. For example, Nakatani discloses a trimming mode for copying portions of an image to be copied (col. 4, lines 18-21) and a masking mode for erasing portions of an image to be copied (col. 4, lines 20-23). In Bruce, as one of ordinary skill would recognize, a document submitted to printing device 130 by a user would not benefit from adding such simple editing commands at printing device 130 when much more powerful editing can be done on the source client computers 120, 123 and 126, such as by using client software 121. Thus, it would not have been obvious (and there would have been no need) to modify the printing device 130 of Bruce by Nakatani.

Fourth, the Office Action's reason for making the proposed combination, that it would provide "highly efficient edited-image copying" is not correct. Nakatani discloses that copy machines that enable editing are inefficient because it takes a long time for users to edit images for copying on a copy machine, causing other users to wait (col. 1, lines 17-23). Nakatani addresses this problem by providing the standalone input unit 901 that enables entry of editing data by users without holding up use of the copy machine. One of ordinary skill would have known that in printing systems such as disclosed by Bruce, Nakatani's solution would provide highly inefficient editing compared with the editing available on network host

devices such as Bruce's client computers 120, 123 and 126, which originate the print requests in Bruce. Thus, one of ordinary skill would not have regarded the Office Action's citation to Nakatani as being a reason to make the proposed combination.

For the foregoing reasons, the rejections of independent claims 1, 15, 29 and 36, and their dependent claims, are patentable over the applied references.

B. Dependent Claims 11-14, 25-28 and 35

Regarding dependent claims 11-12, 25-26 and 35, the applied references fail to disclose the step of, and the controller/editing means that enables, "editing of the printing data when an information processor which has transmitted the printing data is identical to an information processor which requests the editing of the printing data". Regarding dependent claims 13-14 and 27-28, the applied references fail to disclose a controller/editing means that "enables the editing of the printing data when user information added to the printing data is identical to user information input by a user who requests editing".

The Office Action acknowledges that Bruce and Nakatani fail to disclose the features quoted above, but alleges that Yellapeddy cures these deficiencies.

Yellapeddy, applied in relation to claims 11-14, 25-28 and 35, does not cure the deficiencies of Bruce and Nakatani. Yellepeddy discloses a system which provides print support when the connection to a remote printer is lost. Yellepeddy discloses a data processing system 102 such as a desktop or mobile computing device (Fig. 1; col. 2, lines 57-62) connected to a print server/printer 108 over a network 106 (Fig. 1). When the connection to the remote print server/printer 108 is lost or the user cannot access the print server/printer 108, a mobile print manager 202 creates a transient print queue 206 that stores the desired print requests (col. 4, lines 10-18). When access to the print server/printer 108 is achieved, the transient print queue can be replayed and the print requests submitted to the print server/printer 108 (col. 4, lines 18-29).

Yellepeddy fails to cure the deficiencies of Bruce because, while Yellepeddy discloses the ability to edit (ASCII only) versions of a print job (col. 7, lines 8-11), Yellepeddy does not disclose that the editing can occur only when an information processor which has transmitted the printing data is identical to an information processor which requests the editing of the printing data or that the editing can occur only when user information added to the printing data is identical to user information input by a user who requests editing, as claimed.

For the foregoing reasons, the applied references additionally fail to disclose the features of dependent claims 11-14, 25-28 and 35.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Jonathan H. Backenstose
Registration No. 47,399

JAO:JHB

Date: January 28, 2009

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
